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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,126	12/02/2003	Nosakhare D. Omoigui	MS1-418USC1	3534

22801 7590 10/16/2007

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EXAMINER	
AUSTIN, SHELTON W	

ART UNIT	PAPER NUMBER
2623	

MAIL DATE	DELIVERY MODE
10/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/726,126	OMOIGUI, NOSAKHARE D.	
	Examiner	Art Unit	
	Shelton Austin	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/02/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Allowance of application claims 1, 7, 12, 20, 27 and 32 would result in an unjustified time-wise extension of the monopoly previously granted for the invention as specified in patent claims 1-62, therefore obviousness-type double patenting is proper.

2. Claims 1, 7, 12, 20, 27 and 32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 13, 37, 41, 52 and 53 of U.S. Patent No. 6,694,352. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or

descriptions of the same subject matter varying in breadth. For example, note the following relationship between the instant application claims and the patented claims.

a) the preamble of application claim 1 corresponds to the preamble of patented claim 1;

b) the claimed "receiving source information from at least one source..." (lines 2-5) step of application claim 1 corresponds to the "receiving source information from at least one source..." (lines 3-7) step of patented claim 1;

c) the claimed "evaluating the source information against user information that gives an indication of broadcast events..." (lines 6-7) step of application claim 1 corresponds to the "evaluating the source information against user information that gives an indication of electronic presentations..." (lines 8-11) step of patented claim 1;

d) the claimed "making one or more broadcast events available to one or more users if...it appears that the one or more users would be interested..." (lines 8-10) step of application claim 1 is inclusive to the "generating a notification to one or more users if...it appears that the one or more users would be interested..." (lines 12-15) step of patented claim 1;

It would have been obvious to one of ordinary skill in the art to readily recognize that the conflicting claims are different definitions or descriptions of the same subject matter varying in breadth. In this case, the application claims are broader and inclusive to the patented claims.

Claims 7, 20 and 27 of the application correspond to claims 1, 52 and 53 of the patent.

Claims 12 and 32 of the application correspond to claims 13, 37 and 41.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5, 6, 10, 11, 25, 26, 30 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 5, 6, 10, 11, 25, 26, 30 and 31, the applicant recites "said acts" in line 1. There are no "acts" to refer to in the preceding claims, therefore the claims lack antecedent basis and are vague and indefinite. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Chernock et al. (US 6,813,776).

Regarding claims 1 and 20, Chernock teaches a method comprising:

receiving source information from at least one source of one or more television programs, the source information describing one or more broadcast events that can occur during a time period within which television programs are broadcast (abstract—reception of TV or data download program; col. 3, lines 57-63 and col. 4, lines 21-33);

evaluating the source information against user information (col. 4, line 64-col. 5, line 5—user information) that gives an indication of broadcast events that are of interest to a user (col. 2, lines 46-53; col. 5, lines 51-54); and

making one or more broadcast events available to one or more users if, as a result of said evaluating, it appears that the one or more users would be interested in said one or more broadcast events (col. 2, line 61-col. 3, line 8; col. 5, lines 51-54—determining a match corresponds to "if it appears that the one or more users would be interested...").

Regarding claims 2, 8, 21, 22 and 28, Chernock teaches wherein one or more broadcast events do not pertain to information associated with the television programs (abstract and col. 6, lines 17-20—data download program).

Regarding claims 3 and 23, Chernock teaches wherein the act of making comprises displaying one or more broadcast events for a user (col. 2, lines 64-65; col. 5, lines 10-13; col. 6, lines 30-32—tuning to the selected multimedia presentation).

Regarding claims 4, 9, 14, 24, 29 and 34, Chernock teaches wherein the act of making comprises recording one or more broadcast events for a user (col. 2, line 66-col. 3, line 4; col. 5, lines 10-14; col. 6, lines 21-25).

Regarding claims 5, 10, 16, 25, 30 and 36, Chernock teaches wherein said acts are performed by a television set (col. 3, lines 51-52; col. 4, line 47).

Regarding claims 6, 11, 17, 26, 31 and 37, Chernock teaches wherein said acts are performed by a set-top box (col. 3, line 51; col. 4, line 47).

Regarding claims 7 and 27, Chernock teaches a method comprising:

receiving source information from at least one source of one or more television programs, the source information describing one or more broadcast events that can occur during a time period within which the television programs are broadcast

(abstract—reception of TV or data download program; col. 3, lines 57-63 and col. 4, lines 21-33);

evaluating the source information against user information (col. 4, line 64-col. 5, line 5—user information) that gives an indication of broadcast events that are of interest to a user (col. 2, lines 46-53; col. 5, lines 51-54); and

making one or more broadcast events available to one or more users if, as a result of said evaluating, it appears that the one or more users would be interested in said one or more broadcast events (col. 2, line 61-col. 3, line 8; col. 5, lines 51-54—determining a match corresponds to "if it appears that the one or more users would be interested..."), said act of making being performed independent of whether a user is operating a television on which the television programs can be played (col. 2, lines 46-53; col. 4, line 64-col. 5, line 14—automatic scheduling, automatic tuning to the multimedia presentation and automatic recording are all "independent of whether a user is operating a television on which the television programs can be played").

Regarding claims 12 and 32, Chernock teaches a method comprising:

receiving user information from a user, the user information describing one or more broadcast events that can occur during a time period in which television programs are broadcast (col. 2, lines 46-53—user preference information);

receiving source information from one or more sources of television programs (abstract—reception of TV or data download program; col. 3, lines 57-63 and col. 4, lines 21-33);

evaluating the source information to determine whether any of the one or more broadcast events that have been specified by a user occur (col. 2, lines 46-53; col. 5, lines 51-54); and

if one or more broadcast events occur, making an occurring broadcast event available for a user to watch (col. 5, lines 5-15).

Regarding claims 13 and 33, Chernock teaches wherein said act of making comprises generating and sending a notification to the user (col. 5, lines 5-10—a scheduling icon notifies the user of scheduling information).

Regarding claims 15 and 35, Chernock teaches wherein said acts of receiving source information, evaluating and making occur independent of whether a television on which programs can be played is turned on for playing programs (col. 2, lines 46-53; col. 4, line 64-col. 5, line 14—automatic scheduling, automatic tuning to the multimedia presentation and automatic recording; col. 6, lines 30-31—TV is turned on automatically if it is off when the event occurs).

Regarding claims 18 and 38, Chernock teaches wherein said acts of receiving source information, evaluating and making are performed relative to a television program that the user is not currently watching (col. 2, lines 19-22).

Regarding claims 19 and 39, Chernock teaches wherein said acts of receiving source information, evaluating and making are performed relative to a television program that the user is not currently watching (col. 2, lines 19-22) and during a time period when a different television program is playing on a television (col. 6, lines 1-25).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelton Austin whose telephone number is (571) 272-9385. The examiner can normally be reached on Monday through Thursday from 8:00-5:30. The examiner can also be reached on Fridays from 9:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant, whose telephone number is (571) 272-7294, can be reached on Monday through Friday from 7:30-5:00. The supervisor can also be reached on alternate Fridays from 9:00-4:00. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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